

concludes (also under the recapture doctrine) that, because claim 1 in the '829 application included limitation (f), and claim 5 in the '505 application did not, any claims sought in reissue must contain limitation (f).

Since current caselaw holds that the recapture doctrine applies only with respect to the original application under reissue, and not other family member applications, the conclusions of the Office Action contravene the present state of the law, and the applicant therefore respectfully requests withdrawal of the rejection.

II. The Recapture Doctrine

The patent laws, as codified in 35 USC § 251, allow for reissue of a patent whenever, "through error and without deceptive intent," a patent is found to be flawed "by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." The term "error" used in the statute has been construed broadly by the courts in interpreting the meaning of this statute. For example, the failure of an attorney to appreciate the full scope of an invention has been held by the courts to be an error correctable through reissue.² However, the courts have also held that a deliberate surrender of subject matter during prosecution of claims in "the original patent"³ is not an error correctable through reissue, and the recapture doctrine was judicially created for rejecting and invalidating claims that include surrendered subject matter.

The recapture doctrine has a long history, which may be traced back as far as the *Leggett v. Avery*⁴ decision of 1880, in which the Supreme Court called claims that had been allowed by the Patent Office, even though previously abandoned by the patentee, "immense frauds on the public." A good summary of the recent case law on the recapture doctrine is provided by the Federal Circuit by the *In re Clement* case, which explains clearly what the recapture doctrine is and how it should be applied.⁵

² pending independent claim 2 includes the following limitation: "said chain and knife members are linked to one another by one of said link members. . ." This limitation is similar to the fourth reason given by the applicant on June 17, 1997, that "Pearson's link members 13 do not link adjacent chain members as do Applicant's link members."

³ See *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984)

⁴ The term "the original patent" is used in 35 USC § 251 to describe the patent that is subject to reissue.

⁵ 101 U.S. 256, 25 L. Ed. 865 (S. Ct. 1880)

⁵ Other older case law on the recapture doctrine includes: *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); and *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

A. The Two Step Test for the Recapture Doctrine

In the *In re Clement* decision⁶, the Federal Circuit set forth a two step test for deciding whether the recapture doctrine should apply to a set of claims in a reissue patent or patent application.⁷ The two step test includes steps of determining: (1) whether and in what aspect the reissue claims are broader than the claims originally issued; and (2) whether the broader aspects of the reissue claims relate to subject matter that was surrendered by the applicant during prosecution of the original claims.⁸ Examples given of acts by which an applicant could satisfy the second step of the two step test included both arguments and narrowing amendments to the claims made in an effort to overcome a prior art rejection. The claims of the present reissue application are broader in some respects than the claims of the '829 application. However, as explained in more detail below, there is no evidence on the record of the original patent that the applicant had previously surrendered those aspects of the present reissue claims that are broader. Hence, the second part of the *In re Clement* test is not met, and the rejection of the pending claims under the recapture doctrine should be withdrawn.

1. Surrender by Narrowing Amendment

The *In re Clement* court offered additional guidance on how and when the second part of the two part test would apply:⁹

Although the recapture rule does not apply in the absence of evidence that the applicant's amendment was "an admission that the scope of that claim was not in fact patentable," the court may draw inferences from changes in claim scope when other reliable evidence of the patentee's intent is not available.

The second part of the *In re Clement* test cannot be satisfied by the facts of the present reissue application because there is no record of any changes to the claims in the prosecution

⁶ 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997) The *In re Clement* case is also cited and discussed in the MPEP §1412.02, 8th edition, which explains further how the doctrine of recapture should be applied in reissue prosecution, but without reference to the most recent case law, including *Pannu v. Storz* (see below).

⁷ In 2001, the Federal Circuit issued their most recent ruling on the recapture doctrine. In *Pannu v. Storz Instruments, Inc.* 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), the Federal Circuit modified the two step test set forth in *In re Clement* by adding a third step of determining "whether the reissued claims were materially narrowed in other respects to avoid the recapture rule." Because the pending claims in the present reissue application recite limitations not present in the claims of the original patent, the new third step in the *Pannu v. Storz* decision further strengthens the applicant's position that a rejection under the recapture doctrine is improper.

⁸ *In re Clement*, Ibid. at 1468-1469

⁹ Ibid. at 1469 (citations omitted)

history of U.S. Patent No. 5,845,474 (the ‘829 application), which is the original patent for the present reissue application.

2. Surrender by Argument

Although narrowing amendments are the clearest indication of where an applicant may have surrendered subject matter during the prosecution of claims in an original patent, the *In re Clement* court also suggested that the second step could be satisfied by “arguments. . . made in an effort to overcome a prior art rejection.”¹⁰

Again, the second part of the *In re Clement* test cannot be satisfied by the facts of the present reissue application. As noted in the Office Action of August 30, 2002, the ‘829 application was allowed after a first Office Action, and there are no arguments by the applicant on record.

3. Reliance on the ‘505 application is improper

In spite of the lack of a record that may serve as the basis for a rejection under the recapture doctrine in the ‘829 application, the claims of the present reissue application have been rejected, in the Office Action of August 30, 2002, on the basis of arguments made in the ‘505 application. In addition, the Office Action considers the claims of the ‘829 application as a narrowing amendment to the claims of the ‘505 application. Thus, the Office Action of August 30, 2002 argues that the prosecution history of the ‘505 application serves as a record of how the applicant has surrendered subject matter both by arguments and by narrowing amendments. But the use of the prosecution history of the ‘505 application for a rejection of the claims of the present reissue application is not in keeping with recent judicial interpretation of 35 USC § 251.

In October 1998, the U.S. District Court for the District of Massachusetts ruled in *U.S. Filter Corp. v. Ionics, Inc.*¹¹ that the recapture doctrine applies only to subject matter surrendered in the prosecution history of the patent for which reissue is sought (i.e., the “original patent” in 35 USC § 251), and not to subject matter argued or amended in other family patents. In this case, the plaintiff had sued the defendant for infringement of claims that had been reissued. The defendant argued, among other things, that the reissued claims were invalid under the recapture doctrine on the basis of arguments and amendments made not in the reissued patent, but in family patents. In response, the plaintiff argued that “the original patent” in 35 USC § 251 means specifically the patent to which the examiner looks to correct the alleged “error.” After hearing arguments from both sides, the Court concluded the following:

¹⁰ Ibid. The Federal Circuit more recently reaffirmed that surrender could be made by arguments alone in 1998 in *Hester Industries, Inc. v. Stein, Inc.* 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998).

¹¹ 68 F.Supp.2d 48, 53 USPQ2d 1071. For the Examiner’s convenience, a copy of the case is enclosed.

[N]o good reason exists to interpret the word “original” in the § 251 of the Patent Act to mean anything other than its common-sense meaning; the “original” patent is the patent corrected by the reissue patent. . . Therefore, I conclude that I must look only to the prosecution history of the ‘809 Patent, the “original” patent with regard to [the reissued patent] in order to determine whether language. . . was surrendered during prosecution of the ‘809 Patent in order to overcome some prior art rejection, which would then render the corresponding claims of [the reissued patent] invalid.¹²

Thus, in keeping with current judicial precedent on the interpretation of “original” in 35 USC § 251, it is improper for the ‘505 application to be used in rejecting the claims of the present reissue application under the recapture doctrine.

III. Conclusion

In summary, the recapture doctrine is a judicially created limit to the interpretation of the term “error” in 35 USC § 251. The recapture doctrine is applied using a three step test of determining: (1) whether and in what aspect the reissue claims are broader than the claims in the original patent; (2) whether the broader aspects of the reissue claims were surrendered by arguments or amendments during prosecution of the original patent; and (3) whether the reissue claims are materially narrower than the claims of the original patent in other respects. The record of arguments and amendments for “the original patent” is the prosecution history of the patent being reissued, and does not include the prosecution history of family patents.

The prosecution history of the ‘829 application is in this case the record of the original patent. That record does not include any arguments or amendments, and thus must fail the second step of the three step test. The rejection of the presently pending claims under the doctrine of recapture is improper, and the applicant respectfully requests for the rejection to be withdrawn.

¹² Ibid. at 71-72

In re Appln. of Thomas E. Rupp
Application No. 09/541,162

In view of the foregoing remarks, the application is considered in good and proper form for allowance, and the Examiner is requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned representative.

Respectfully submitted,



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Date: February 28, 2003

Certification under 37 C.F.R. § 1.10

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February 28, 2003

Express Mail mailing number

Date of Deposit

I hereby certify that the attached Response to Office Action of 30 August 2002, including any documents or materials referred to thereon as enclosures or attachments, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to Commissioner for Patents, Washington, DC 20231.

Laura A. Wells

(Typed or printed name or person making deposit)

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(Signature of person making deposit)

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